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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/572,733 | 01/12/2007 | Hiroaki Yamamoto | 020357 097P2 | 6898 |

33805 7590 04/09/2008
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| EXAMINER |
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HEITBRINK, JILL LYNNE

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| ART UNIT | PAPER NUMBER |
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1791

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| MAIL DATE | DELIVERY MODE |
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04/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| Office Action Summary | Application No. 10/572,733 | Applicant(s) YAMAMOTO, HIROAKI | |
| | Examiner Jill L. Heitbrink | Art Unit 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4 and 8 are indefinite for the following reason(s): Claim 1 step (a) states that X, Y, and Z are perpendicular to each other. Claim 1 step (c) states “a rearward boundary extending away from said forward boundary in the Y direction” but the sloped bottom wall is at an angle to the Y direction. Claim 4 states “moving said female member away from said male member along said Y direction” but the movement is at an angle. Claim 8, lines 11 and 12 state “a rearward boundary space rearwardly from said major surface along said Y direction” and then states “said bottom inclined wall disposed at an angle of between about 1 degree to about 20 degree relative...” which statement is contradictory.

Claim 4, line 6 and 7 is unclear as to what “is also parallel to said tangent line”. The claim is being examined with the Y direction being parallel to the tangent line since this is defined in claim 1, lines 18 and 19 and the female member does not move parallel to the tangent line as shown in Fig. 3A.

Claim Rejections - 35 USC § 102

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 8-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamamoto Pat. No. 5,746,962.

5. Yamamoto '962 discloses a prior art "c" shaped elongated automotive part in Figs. 2 and 2a with a substantially linear sloped bottom wall (left wall shown in Fig. 2 is a bottom wall when the figure is rotated 90 degrees) having a slope of 1 to about 20 degrees and 1 to about 10 degrees relative to a tangent line that touches the forward boundary extending in the Y direction. This Y direction and tangent line are at an angle of about 1 degree from the surface of the bottom wall left wall portion shown in Fig. 2 of Yamamoto. And, this Y direction and tangent line are at an angle of about 20 degrees from the opening closing direction of the mold parts in Yamamoto which would be perpendicular to the parting line shown in Fig. 2. The apex defining a top portion of the part would be the right wall shown in Fig. 2 which is the top portion when the figure is rotated 90 degrees. The major surface (which is indicated by numbers 6 and 30 in Fig. 2) extends between the bottom wall in the nadir cavity (left side wall) and the apex

portion (right side wall). As shown in Fig. 1, 1A, and 2A the paint film 6 terminates between the forward and rearward boundary of the bottom wall surface.

6. Claims 8 and 9 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Yoshida et al. Pub. No. 2003/0094835.

7. Yoshida discloses an elongated automotive part with a bottom inclined wall (10c) which is substantially linear and at an angle of 1 to about 20 degrees from a tangent line touching the forward boundary that extends in the Y direction as clearly shown in Fig. 6.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto Pat. No. 5,746,962 taken together with Hirose Pat. No. 6,171,543.

10. Yamamoto '962 discloses a prior art "c" shaped elongated automotive part in Figs. 2 and 2a with a substantially linear sloped bottom wall (left wall shown in Fig. 2 is a bottom wall when the figure is rotated 90 degrees) having a slope of 1 to about 20 degrees and 1 to about 10 degrees relative to a tangent line that touches the forward boundary extending in the Y direction. This Y direction and tangent line is at an angle of about 1 degree from the surface of the bottom wall left wall portion shown in Fig. 2 of Yamamoto. And, this Y direction and tangent line is at an angle of about 20 degrees from the opening closing direction of the mold parts in Yamamoto which would be

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perpendicular to the parting line shown in Fig. 2. The apex defining a top portion of the part would be the right wall shown in Fig. 2 which is the top portion when the figure is rotated 90 degrees. The major surface (which is indicated by numbers 6 and 30 in Fig. 2) extends between the bottom wall in the nadir cavity (left side wall) and the apex portion (right side wall). Yamamoto discloses injecting molten plastic into the cavity. Hirose (col. 9, lines 57-61) teaches the well known steps of cooling the plastic part and removing the part from the mold. The plastic being allowed to cool and the part being removed from the mold cavity would have been obvious in Yamamoto since these are basic steps of injection molding automotive parts known in the art and would have been performed in Yamamoto so as to produce a usable automotive part. As shown in Fig. 1, 1A, and 2A the paint film 6 terminates between the forward and rearward boundary of the bottom wall surface. Hirose teaches the use of a slider section which would be moved along a X direction away from the male mold member at an acute angle relative to the longitudinal axis Z since the axis Z and X are not consider to be the axis of the movement of the mold members but the axis are at an acute angle to the movement of the mold members. It would have been obvious to a person of ordinary skill in the art to provide a slider section in Yamamoto when producing an undercut portion on the nadir cavity wall section.

11. The paint film including a metallic or metallic flake appearance would have been obvious to a person of ordinary skill in the art since these are common appearances of automobile body parts and trim. The part being a side sill garnish would have been

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obvious since the part is disclosed as a body panel or bodyside molding which would have been obviously considered as a garnish on the automobile side body.

12. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose Pat. No. 6,171,543 taken together with Yamamoto Pat. No. 5,746,962.

13. Hirose discloses providing a mold cavity of a C shaped transverse cross section, see Fig. 5. The nadir cavity section has a sloped bottom wall 318. The channel cavity 322 is similar to a forward boundary and a tangent line may be drawn at an angle of 1 to 20 degrees from the direction of opening and closing the mold, perpendicular to the parting line shown in Fig. 5. This drawn tangent line is also 1 to 10 degrees from the sloped bottom wall. Yamamoto teaches the edge walls of the elongated automotive part being substantially linear in Figs. 1 and 2 and alternatively curved as shown in Fig. 3-8. It would have been obvious to a person of ordinary skill in the art to provide a substantially linear bottom wall in Hirose in view of the teaching of Yamamoto since such a bottom wall shape is a mere desired alteration of appearance.

14. Hirose (col. 9, lines 57-61) teaches the well known steps of injection molding, cooling the plastic part and removing the part from the mold. Yamamoto teaches the paint film 6 terminates between the forward and rearward boundary of the bottom wall surface, shown in Fig. 1, 1A, and 2A. It would have been obvious to terminate the paint layer between the forward and rearward boundary in Hirose since this region would not have been a show surface. Hirose discloses a slider section which would be moved along a X direction away from the male mold member at an acute angle relative to the longitudinal axis Z since the axis Z and X are not consider to be the axis of the

movement of the mold members but the axis are at an acute angle to the movement of the mold members, such as perpendicular to the tangent line.

15. The paint film including a metallic or metallic flake appearance would have been obvious to a person of ordinary skill in the art since these are common appearances of automobile body parts and trim. The part being a side sill garnish would have been obvious since the part is disclosed as a body panel or bodyside molding which would have been obviously considered as a garnish on the automobile side body.

Response to Arguments

16. Applicant's arguments filed Dec. 27, 2007 have been fully considered but they are not persuasive.

17. Applicant's comments to the withdrawn angle of female mold member 42 being at an angle of zero degrees have been considered. However, the direction of the X and Y axis are not clearly defined in relation to the mold cavity walls or the shape of the automotive part in the claims. The molds move along the line of the sloped bottom wall so as to remove the part without any problem of an undercut. The X and Y axis does not have any point of reference other than this sloped bottom wall and mold movement direction. Thus, the X and Y axis can be drawn in any location so as to be 1 to 20 degrees from this sloped bottom wall and mold withdrawal direction.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill L. Heitbrink whose telephone number is (571) 272-1199. The examiner can normally be reached on Monday-Friday 9 am -2 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill L. Heitbrink/
Primary Examiner, Art Unit 1791

jlh